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UNDER 37 CFR 1.8(a)

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6 AUGUST 2003
HUESCHEN AND SAGE

S. HUESCHEN SAGE
Dated: 6 August 2003

MERZ 30

* * * * *

Applicant : Christopher Graham Raphael PARSONS, Wojciech DANYSZ, Markus GOLD, Ivars KALVINSH, Valerjas KAUSS, and Aigars JIRGENSONS

Serial No. : 09/597,102

Filed : June 20, 2000

Title : 1-AMINO-ALKYLCYCLOHEXANES AS 5-HT3 AND NEURONAL NICOTINIC RECEPTOR ANTAGONISTS

Art Unit : 1617

Examiner : Shaojia JAING, PhD

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AUG 12 2003

OFFICE OF PETITIONS

Mail Stop PETITION
COMMISSIONER FOR PATENTS
PO Box 1450
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PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED

UNAVOIDABLY UNDER 37 CFR § 1.137(a)

Sir:

Responsive to the Notice of Abandonment dated April 9, 2003, for which a Petition fee is attached, the applicants stipulate as follows:

-In an August 7, 2002 Response and Amendment, and responsive to a Final Rejection dated June 5, 2002, the applicants limited rejected method Claim 14 by deleting selected diseases claimed to be treatable from the list of diseases claimed to be treatable.

-The Office issued an Advisory Action dated August 23, 2003 maintaining the Finality of the prior art rejection because the applicants' above-noted limiting amendment "present[ed] a new issue for search and consideration by the Examiner."

-In a telephonic interview with the Examiner of September 10, 2002, the applicants agreed to add the limitation of the August 7, 2002 Response and Amendment After Final to generic Method Claim 1.

-In accord with the applicants' telephonic interview noted above, the applicants filed a Response After Final on September 10, 2002, adding the limitation of the August 7, 2002 Response and Amendment After Final to generic Method Claim 1. Receipt of the Response After Final was acknowledged by Return Postal Card Receipt of September 16, 2002.

-The applicants submitted Corrected Drawings on December 17, 2002, the receipt of which is acknowledged by Return Postal Card Receipt of December 23, 2003.

-The applicants submitted a Status Inquiry on February 11, 2003, the receipt of which is acknowledged by Return Postal Card Receipt of February 19, 2003.

-The Office issued an Advisory Action on March 19, 2003 indicating that the September 10, 2002 response is non-responsive.

-The Office issued a Notice of Abandonment on April 9, 2003 indicating that the August 12, 2002 response is non-responsive.

Because of USPTO error as to Procedure and with regard to mail handling, the instant Abandonment was UNAVOIDABLE. REVIVAL is solicited. Copies of the above-noted prosecution history are provided for the convenience of the Office.

R E M A R K S

The Applicants acknowledge the Notice of Abandonment issued by the Office, respond that the Abandonment is erroneous, and request REVIVAL for UNAVOIDABLE abandonment. The applicants base this Petition on the fact that the Office erroneously maintained the Finality of the June 5, 2002 Office Action in its August 23, 2002 Advisory Action. As basis for this assertion, the applicants reference the August 23, 2002 Advisory Action, which action

concludes that the applicants' August 7, 2002 Response After Final, deleting conditions claimed to be treatable from Method of Treatment Claim 14, "present[ed] a new issue for search and consideration by the Examiner." It is not possible for an amendment deleting conditions claimed to be treatable from a list of such conditions to present a "new" issue for examination.

In response to this Advisory Action, and recognizing the fact that such a basis for rejection was erroneous, the applicants contacted the Examiner and discussed the Response and Amendment. The Examiner indicated that the limitation which the applicants entered into Claim 14 would have to be entered into generic Method Claim 1. The applicants complied with the suggestions of the Examiner by filing a Response After Final on September 10, 2002, making the limitations of Method Claim 14 in generic Method Claim 1. As noted above, this Response and Amendment is acknowledged received by Return Postal Card Receipt.

Upon Status Inquiry by the applicants and adding confusion to the prosecution of the instant application, the Office issued another Advisory Action, not timely, on March 19, 2003, more than nine (9) months after the original Final Rejection. Upon enquiry of the Examiner's Supervisor, the Office concluded that the instant application had been abandoned for failure of the applicant to respond to the August 12, 2002 Advisory Action. The Notice of Abandonment erroneously does not acknowledge the applicants' September 10, 2002 Response After Final, nor does it acknowledge the Office's March 19, 2003 Advisory Action.

It is submitted that, but for the Advisory Action of August 23, 2002, erroneously maintaining the FINALITY of the June 5, 2003 Office Action based on the inaccurate finding that the applicants' August 7, 2003 Amendment

presented a new issue for consideration, and the inexplicable failure of the Office to acknowledge and act upon the applicants' September 10, 2002 Response After Final, the instant finding of abandonment would have been avoided. Consequently, the applicants request REVIVAL of the instant application because the April 9, 2003 Abandonment was UNAVOIDABLE due to USPTO error. Favorable consideration and REVIVAL are solicited.

Respectfully submitted,

THE FIRM OF HUESCHEN AND SAGE

By: 
G. PATRICK SAGE

Dated: August 6, 2003
Customer No.: 25,666
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Kalamazoo, MI 49007-3856
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Enclosure: Postal Card Receipt,

Petition Fee,

Copy of August 7, 2002 Response and Amendment,

Copy of Advisory Action dated August 23, 2003,

Copy of Response After Final of September 10, 2002,

Copy of Status Inquiry of February 11, 2003,

Copy of Advisory Action of March 19, 2003, and

Copy of Notice of Abandonment of April 9, 2003.